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Client Reference: SB-2

2432
IDW

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

in re PATENT APPLICATION of:

Confirmation Number: 6203

FRANKEL *ET AL.*

Application No.: 09/503,181

Group Art Unit: 2432

Filed: February 14, 2000

Examiner: LEMMA, SAMSON B.

Title: CRYPTOGRAPHIC CONTROL AND MAINTENANCE OF ORGANIZATIONAL
STRUCTURE AND FUNCTIONS

March 3, 2009

RESPONSE TO RESTRICTION REQUIREMENT

Mail Stop Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In response to the Restriction Requirement dated February 3, 2009, Applicant hereby provisionally elects Group I, claims 1-4 and 6-51. This response to the restriction requirement is made with traverse.

At the outset, on a technical matter, the Restriction Requirement refers in paragraph 2 to the options under 37 CFR 1.193(b)(2). First, that rule is no longer in force; it was repealed in 2004. Moreover, Applicant submits there is no authority for the options presented in paragraph 2 of the Restriction Requirement and therefore Applicant submits it is not pertinent. Indeed, the Notice of Panel Decision dated October 14, 2008 states that the "rejection is withdrawn". Thus, there is no rejection pending for the appeal to be reinstated against. Moreover, 37 CFR 1.111 and 1.113 are not applicable to this Restriction Requirement. This is a reply under 37 CFR 1.143.

On the merits, MPEP § 808.02 states: "..., the examiner, in order to establish reasons for insisting upon restriction, must explain why there would be a serious burden on the examiner if restriction is not required." (Underlining emphasis added.) Furthermore, MPEP § 803 states: "If the search and examination of all the claims in an application can be made without serious burden, the examiner must examine them on the merits, even though they

include claims to independent or distinct inventions.” (Underlining emphasis added.) It is respectfully submitted that it is clear from these MPEP sections that it is PTO policy that the entire application must be searched and examined, regardless of the presence of independent or distinct inventions, if no serious burden exists. It is respectfully submitted that the Examiner has not established that a serious burden exists per MPEP § 808.02, as the entire application can be searched and examined without a serious burden as it already has been many times. The Restriction Requirement has not stated any reasons for why there would be a serious burden if there was no restriction.

Applicant originally presented the vast majority of the current pending claims 1-67. The Examiners in this case have already searched and examined those claims 1-89. **In fact, the Examiners in this case have at least examined them eight (8) times over the last almost five and a half (5-1/2) years, and hopefully performed an equal number of searches.** Presumably, the Examiners followed the directives of MPEP Chapter 900, including the sections discussed above, in formulating and conducting the search. If the Examiners did not follow those directives, Applicant should not now be disadvantaged thereby and have the time to prosecute its claims extended.

Further, a Final Action issued in this case on September 7, 2007. Thus, Applicant submits that per the last sentence of 37 C.F.R. §1.142(a), a requirement to restrict is no longer permitted.

Moreover, the Examiner has classified Group I in class 726, subclass 2 and classified Group II in class 707, subclass 9. However, class 707, subclass 9 specifically states to search class 726, subclasses 1-36. Accordingly, irrespective of the Group elected, the Examiner will have to search the same art and thus there will not be any burden on the Examiner to search all the present pending claims.

Thus, Applicant respectfully submits there is not a serious burden to examine the present claims, as the Examiner already has done so and would search essentially the same art in any event. Moreover, there is absolutely no reason to issue a restriction requirement this late in prosecution; nothing has significantly changed over the last 5-1/2 years and 8 Office Actions to merit restriction now and, indeed, Applicant submits it is not even permitted. A requirement to elect only a subset of the pending claims now is materially prejudicial to Applicant as it has spent significant resources to prosecute all the present

claims. Moreover, electing only a subset of the pending claims materially prejudices Applicant's patent term as there is little to no chance that the unelected claims would be examined and granted in a divisional application in the same or shorter time than the elected claims in this application.

MPEP § 808.02 also states: "The examiner, in order to establish reasons for insisting upon restriction, must show by appropriate explanation one of the following: (A) Separate classification thereof; (B) A separate status in the art when they are classifiable together; (c) A different field of search." The Examiner contends that the inventions of Groups I and II have acquired a separate status in the art as shown by their different classification. Class 726, subclass 2 (for Group I) relates to systems, methods, and apparatus for the prevention of unauthorized access to resources of a system or information system, including the manner of identifying and verifying the entity, process, or mechanism requesting access to the resource. Further, class 707, subclass 9 (for Group II) relates to determination and granting of access to data and files by direct means, such as by the file or database creator or database manager, or by indirect means, such as by inheritance, such as by group/user access profiles. Applicant finds no legitimate reasons or coherent rationale for classifying Groups I and II under their respective classes and subclasses. The only aspect that seems relevant to those classifications is the recitation in both Groups of cryptographic capabilities. However, that recitation would commend classification in the same class and subclass, rather separate classification for each Group. Therefore, Applicant respectfully objects to the conclusion that Groups I and II each have acquired a separate status in the art as shown by their different classification. Accordingly, the restriction requirement is improper as Applicant cannot discern Examiner's choice to classify Group I separately from Group II and thus cannot form the basis for the requirement to restrict as asserted in the Restriction Requirement.

If this Restriction Requirement is not withdrawn, Applicant demands that the Examiner withdraw the previous Office Actions and its rejections of the claims (or otherwise Examiner's position is inconsistent). Moreover, if this Restriction Requirement is not withdrawn, Applicant expressly withdraws all arguments previously made regarding any and all claims that are not elected.

Applicant also notes that the U.S. Patent Office would be required to allow non-elected claims if presented in a divisional application filed according the restriction requirement, over this application. No double patenting rejection would be available and the

term of subsequent divisional applications may be longer than the present application due to, for example, patent term extensions. Applicant expressly takes no position on whether the groups of claims are patentably independent or distinct from one another.

Reconsideration and withdrawal of the Restriction Requirement are respectfully requested and all claims be continued to be examined.

Respectfully submitted,

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